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PIP-71-KATZ

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF

KATZ, GARY M.   : ATTN: APPLICATION DIVISION

SERIAL NO.: NEW APPLICATION

FILED: HEREWITH

FOR: TARGETED COMMUNICATIONS
       BASED ON PROMOTIONAL
       RESPONSE

PETITION TO MAKE SPECIAL UNDER M.P.E.P. § 708.02(VIII)

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

I.   Basis For the Petition

Pursuant to MPEP § 708.02(VIII), applicants hereby petition for a special status for this application.

II.   Requirements for Granting Special Status

MPEP § 708.02(VIII) provides five requirements for a grant of special status. The following subsections show that each of these five requirements is met.

A.   Submit Petition and Fee: § 708.02(VIII)(A)

This petition is accompanied by the fee set forth in 37 CFR § 1.17(i).

B.   Agree to an Election Without Traverse: § 708.02(VIII)(B)

Applicants submit that all claims are directed to a single, patentable invention because each claim relates to targeting promotions to a consumer based upon a historical record of the exercise of promotions. However, should the Office determine that all the

claims presented are not directed to a single invention, applicants agree to elect the largest group of claims that includes Claim 1.

C. State that a Pre-examination Search Was Made: § 708.02(VIII)(C)

A preexamination search was made. The pre-examination search included a search of the following class and subclasses: class 705, subclasses 10, 14, 26, 54, and 76. Examiner Gail Hayes of Art Unit 2761 was consulted regarding the field of search.

D. Submit a Copy of the Most Relevant References: § 708.02(VIII)(D)

Copies of the references discussed below are submitted with the information disclosure statement and form PTO-1449, filed herewith.

E. Submit a Detailed Discussion of the References, Pointing Out How the Claimed Subject Matter is Patentable Over the References: § 708.02(VIII)(E)

Independent Claim 1 includes features not taught or suggested by the references deemed most relevant to the claims. Specifically, Claim 1 defines a method comprising the steps of receiving identification information from a consumer, identifying said consumer based upon said received identification information, retrieving an exercised promotions denominator related to a promotion exercised by said identified consumer, and determining a targeted promotion likely to be exercised based at least in part upon said retrieved exercised promotions denominator.

U.S. Patent 6,105,002 to Powell describes a method and system for distributing electronic coupons by operating a store and a plurality of portable cards transported by customers. "Smart card" product stations are provided adjacent to selected products in the store and at a checkout counter. To create an electronic coupon, the customer inserts the card into the product station adjacent to a product that the customer wishes to purchase, and the

product station then writes an electronic coupon onto the card which is later redeemed at the checkout station. However, the Powell reference fails to describe or suggest a method that includes receiving identification information from a consumer, identifying said consumer based upon said received identification information, retrieving an exercised promotions denominator related to a promotion exercised by said identified consumer, and determining a targeted promotion likely to be exercised based at least in part upon said retrieved exercised promotions denominator.

U.S. Patent 6,026,370, to Jermyn describes a method and apparatus for generating purchase incentives based upon prior purchase history. A consumer's purchase transactions are used to customize a purchase incentive package, and post-processing provides reports of incentive response and redemption rates. However, the Jermyn reference fails to describe or suggest a method that includes receiving identification information from a consumer, identifying said consumer based upon said received identification information, retrieving an exercised promotions denominator related to a promotion exercised by said identified consumer, and determining a targeted promotion likely to be exercised based at least in part upon said retrieved exercised promotions denominator.

U.S. Patent 5,982,892, to Hicks et al. describes a system and method for controlling unauthorized access to software distributed to a user by a vendor. Identifying information is sent a user key generator, which converts the user identifying information to a numeric representation and then generates a user key, which is returned to the user. The system verifies the relationship between the user key and the user identifying information every time the software is run to ensure continued protection of the software after installation. However, the Hicks et al. reference fails to describe or suggest a method that includes receiving identification information from a consumer, identifying said consumer based upon said

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received identification information, retrieving an exercised promotions denominator related to a promotion exercised by said identified consumer, and determining a targeted promotion likely to be exercised based at least in part upon said retrieved exercised promotions denominator.

U.S. Patent 5,918,213, to <u>Bernard et al.</u> describes a system and method for automated remote previewing and purchasing of music, video, software, and other multimedia products. The automated product purchasing system is capable of supporting and offering various promotions to the customers according to a plurality of scenarios, as described in, e.g., col. 6, line 30-48. However, the <u>Bernard et al.</u> reference fails to describe or suggest a method that includes receiving identification information from a consumer, identifying said consumer based upon said received identification information, retrieving an exercised promotions denominator related to a promotion exercised by said identified consumer, and determining a targeted promotion likely to be exercised based at least in part upon said retrieved exercised promotions denominator.

U.S. Patent 5,892,827, to <u>Beach et al.</u> describes a method and apparatus for generating personal identification numbers for incentive awards in consumer transactions. These personal identification numbers are generated immediately prior to distribution of a certificate with which the code is associated. The triggers that lead to the generation of incentive awards are described in, e.g., col. 6, line 3-15. However, the <u>Beach et al.</u> reference fails to describe or suggest a method that includes receiving identification information from a consumer, identifying said consumer based upon said received identification information, retrieving an exercised promotions denominator related to a promotion exercised by said identified consumer, and determining a targeted promotion likely to be exercised based at least in part upon said retrieved exercised promotions denominator.

U.S. Patent 5,857,175, to Dey et al. describes a system and a method for offering targeted discounts to customers. This system makes special offers to targeted customers and collects purchase behavior information concerning the customers. Column 3, line 57 through column 4, line 9, describe certain factors that may be used by the system and method of Dey et al. to determine customized promotions. However, the Dey et al. reference fails to describe or suggest a method that includes receiving identification information from a consumer, identifying said consumer based upon said received identification information, retrieving an exercised promotions denominator related to a promotion exercised by said identified consumer, and determining a targeted promotion likely to be exercised based at least in part upon said retrieved exercised promotions denominator.

U.S. Patent 5,832,457, to O'Brien et al. describes a method and an apparatus for the selective distribution of discount coupons based upon prior customer behavior. The method of O'Brien et al. comprises the steps of preselecting triggering products, detecting the purchase of a triggering product, and saving customer purchase data concerning the purchase of triggering products. An example of the use of such triggering products is described in column 3, lines 37-57. However, the O'Brien et al. reference fails to describe or suggest a method that includes receiving identification information from a consumer, identifying said consumer based upon said received identification information, retrieving an exercised promotions denominator related to a promotion exercised by said identified consumer, and determining a targeted promotion likely to be exercised based at least in part upon said retrieved exercised promotions denominator.

U.S. Patent 5,822,735, to De Lapa et al. describes a merchandising system for generating and redeeming product discount coupons. A method according to one aspect of this invention includes identifying a particular consumer, printing a packet of coupons for the

identified customer, transmitting the packet to the consumer, identifying which coupons in the packet the consumer uses, and printing another packet of coupons for that consumer. This is described, e.g., in column 3, lines 23-40. However, the De Lapa et al. reference fails to describe or suggest a method that includes receiving identification information from a consumer, identifying said consumer based upon said received identification information, retrieving an exercised promotions denominator related to a promotion exercised by said identified consumer, and determining a targeted promotion likely to be exercised based at least in part upon said retrieved exercised promotions denominator.

U.S. Patent 5,774,868, to Cragun et al. describes an automatic sales promotion selection system and method. This automated sales promotion selection system uses neural networks to identify promising sales promotions based on recent customer purchases. However, the Cragun et al. reference fails to describe or suggest a method that includes receiving identification information from a consumer, identifying said consumer based upon said received identification information, retrieving an exercised promotions denominator related to a promotion exercised by said identified consumer, and determining a targeted promotion likely to be exercised based at least in part upon said retrieved exercised promotions denominator.

U.S. Patent 5,687,322, to Deaton et al. describes a method and a system for selective incentive point of sale marketing in response to customer shopping histories. In addition to the automatic targeting of individual customers based upon their shopping history, the redemption and efficiency of the coupons are subsequently monitored and subsequent coupons are varied in dependency upon the monitoring. See, for example, column 7, lines 43-47. However, the Deaton et al. reference fails to describe or suggest a method that includes receiving identification information from a consumer, identifying said consumer

based upon said received identification information, retrieving an exercised promotions denominator related to a promotion exercised by said identified consumer, and determining a targeted promotion likely to be exercised based at least in part upon said retrieved exercised promotions denominator.

U.S. Patent 5,612,527, to <u>Ovadia</u> describes a discount offer redemption system and method. This system further executes a method of tracking the purchasing habits of individuals who receive and use discount flyer offers by creating a database file including the user name or resident's address for items purchased using the flyer/circular program. However, the <u>Ovadia</u> reference fails to describe or suggest a method that includes receiving identification information from a consumer, identifying said consumer based upon said received identification information, retrieving an exercised promotions denominator related to a promotion exercised by said identified consumer, and determining a targeted promotion likely to be exercised based at least in part upon said retrieved exercised promotions denominator.

U.S. Patent 5,515,270, to <u>Weinblatt</u> describes a technique for correlating the purchase behavior of a consumer to advertisements. This apparatus obtains and stores information on the purchasing behavior of a consumer as well as the advertisements to which the consumer has been exposed. However, the <u>Weinblatt</u> reference fails to describe or suggest a method that includes receiving identification information from a consumer, identifying said consumer based upon said received identification information, retrieving an exercised promotions denominator related to a promotion exercised by said identified consumer, and determining a targeted promotion likely to be exercised based at least in part upon said retrieved exercised promotions denominator.

U.S. Patent 5,504,519, to <u>Remillard</u> describes a method and an apparatus for printing coupons. This method and apparatus allow users to select a desired service from among several services displayed in a menu by operation of a remote keypad. However, the <u>Remillard</u> reference fails to describe or suggest a method that includes receiving identification information from a consumer, identifying said consumer based upon said received identification information, retrieving an exercised promotions denominator related to a promotion exercised by said identified consumer, and determining a targeted promotion likely to be exercised based at least in part upon said retrieved exercised promotions denominator.

U.S. Patent 5,502,636, to <u>Clarke</u> describes a personalized coupon generating and processing system. In this system, the availability of preselected coupons is communicated to consumers and consumers respond to the communication. A coupon dispensing source dispenses personalized coupons to responsive consumers. However, the <u>Clarke</u> reference fails to describe or suggest a method that includes receiving identification information from a consumer, identifying said consumer based upon said received identification information, retrieving an exercised promotions denominator related to a promotion exercised by said identified consumer, and determining a targeted promotion likely to be exercised based at least in part upon said retrieved exercised promotions denominator.

U.S. Patent 5,380,991, to <u>Valencia et al.</u> describes a paperless coupon redemption system and method. An integrated circuit smart card is inserted into a reader or writer terminal provided at a retailer's checkout counter. Items which are to be purchased are compared with items that are to be discounted as well as other information provided on the customer integrated circuit smart card. After the cashier has totaled the customer's purchases, the information contained in the integrated circuit smart card is altered accordingly.

However, the <u>Valencia et al.</u> reference fails to describe or suggest a method that includes receiving identification information from a consumer, identifying said consumer based upon said received identification information, retrieving an exercised promotions denominator related to a promotion exercised by said identified consumer, and determining a targeted promotion likely to be exercised based at least in part upon said retrieved exercised promotions denominator.

U.S. Patent 5,201,010, to <u>Deaton et al.</u> describes a method and a system for building a database and performing marketing based upon prior shopping history. This invention is a check transaction processing system that uses a customer's checking account number as a unique customer identification number. This unique customer identification number is used to establish customer records that include customer information such as check verification data as well as other selected transactional data such as transaction frequency and dollar volume. However, the <u>Deaton et al.</u> reference fails to describe or suggest a method that includes receiving identification information from a consumer, identifying said consumer based upon said received identification information, retrieving an exercised promotions denominator related to a promotion exercised by said identified consumer, and determining a targeted promotion likely to be exercised based at least in part upon said retrieved exercised promotions denominator.

U.S. Patent 3,959,624, to <u>Kaslow</u> describes a coded merchandising coupon entitling its holder to a specified discount on a particular consumer item. These coupons have not only the name of the item but also the amount that the purchase price is to be reduced by in code indicia. However, the <u>Kaslow</u> reference fails to describe or suggest a method that includes receiving identification information from a consumer, identifying said consumer based upon said received identification information, retrieving an exercised promotions

denominator related to a promotion exercised by said identified consumer, and determining a targeted promotion likely to be exercised based at least in part upon said retrieved exercised promotions denominator.

Accordingly, independent Claim 1, which recites a method comprising the steps of receiving identification information from a consumer, identifying said consumer based upon said received identification information, retrieving an exercised promotions denominator related to a promotion exercised by said identified consumer, and determining a targeted promotion likely to be exercised based at least in part upon said retrieved exercised promotions denominator, is believed to patentably distinguish over the references discussed above. Since Claims 2-18 depend from Claim 1, it is also respectfully submitted that Claims 2-18 patentably distinguish over the references discussed above for at least the same reasons as independent Claim 1.

Moreover, independent Claim 19 recites a method which comprises obtaining promotion information related to a particular promotion, comparing said received promotion information to a plurality of exercised promotion denominators based on promotions exercised by a plurality of consumers, and selecting a targeted consumer from said plurality of consumers based at least in part upon said plurality of exercised promotion denominators, said targeted consumer being likely to exercise said particular promotion. It is thus also believed that independent Claim 19 patentably distinguishes over the references discussed above. Since Claims 20-36 depend from Claim 19, it is also respectfully submitted that Claims 20-36 patentably distinguish over the references discussed above for at least the same reasons as independent Claim 19.

Finally, independent Claim 37 recites a method which comprises receiving a request for a provision of targeted promotions, said request including at least one parameter related to

said provision of targeted promotions, selecting likely exercisers of a targeted promotion from a plurality of consumers based at least in part upon promotions exercised by said likely exercisers, determining a targeted promotion likely to be exercised by said likely exercisers based at least in part upon promotions exercised by said likely exercisers, and providing information related to at least one of said selected likely exercisers and said determined targeted promotion, wherein said at least one parameter related to said provision of targeted promotions is used in at least one of said selecting step and said determining step. It is thus also believed that independent Claim 37 patentably distinguishes over the references discussed above. Since Claims 38-56 depend from Claim 37, it is also respectfully submitted that Claims 38-56 patentably distinguish over the references discussed above for at least the same reasons as independent Claim 37.

Since Claims 57-88 recite a system suitable for performing, e.g., the above-discussed methods, it is also respectfully submitted that Claims 57-88 patentably distinguish over the references discussed above for at least the same reasons as independent Claims 1, 19, and 37.

Since Claim 89 recites a computer readable medium containing program instructions for execution on a computer system, which when executed by the computer system, cause the computer system to perform the method recited in any one of claims 1 to 56, it is also respectfully submitted that Claim 89 patentably distinguishes over the references discussed above for at least the same reasons as independent Claim 1, 19, and 37.

III.   Conclusion

The petition to make special should be granted. Therefore, applicants respectfully

request that this application be advanced out of turn for examination.

Respectfully submitted,

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